

The opinion in support of the decision being entered today was not written
for publication and is not binding precedent of the Board.

Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte DAVID J. LONG, PAUL A. KRUPA and DAVID J. MANSFIELD

Appeal No. 2001-2213
Application No. 09/399,418

ON BRIEF

Before ABRAMS, NASE, and BAHR, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 4,
which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to tools that are useful for sanding corners in rooms that have been roughed out with drywall materials and optionally plaster to cover joints between drywall materials (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Burtch et al. (Burtch)	3,707,059	Dec. 26, 1972
Walsh	5,337,523	Aug. 16, 1994

Claims 1 to 4 stand rejected under 35 U.S.C. § 103 as being unpatentable over Walsh in view of Burtch.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the answer (Paper No. 11, mailed April 10, 2001) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 10, filed February 2, 2001) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 to 4 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

In the rejection before us in this appeal (answer, pp. 3-4) the examiner determined that (1) Walsh discloses a tool comprising a compressible elastomer rubber sponge

material having first and second planar surfaces which are coated with an abrasive material (see figure 6) and grasping means with indentations; (2) Burtch discloses a sanding tool having a sponge material made from open-celled foamed polyurethane allowing the tool to be more flexible; (3) Walsh does not disclose the sponge material being open-celled foamed polyurethane; and (4) it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the elastomer rubber sponge material of Walsh by forming it from an open-celled foamed polyurethane material as taught by Burtch.

Claim 1, the only independent claim on appeal reads as follows:

A sanding tool comprising a compressible sponge formed from an open-celled foamed polyurethane, said sponge having first and second planar surfaces meeting at a right angle, said surfaces being coated with an abrasive material in at least the area of the surfaces adjacent the right angle and, in the portion of the sponge enclosed between the first and second surfaces, a grasping means forming an integral portion of the sponge.

Based on our analysis and review of the embodiment of Walsh's utility tool relied upon by the examiner and claim 1, it is our opinion that the examiner did not correctly ascertain the differences.¹ In that regard, in addition to the difference noted by the

¹ After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ (continued...)

examiner (i.e., that Walsh does not disclose the sponge material² being open-celled foamed polyurethane) Walsh fails to teach "first and second planar surfaces meeting at a right angle, said surfaces being coated with an abrasive material in at least the area of the surfaces adjacent the right angle." The first and second planar surfaces of Walsh's utility tool that support sandpaper or the like do not meet at a right angle. Accordingly, even if the examiner were correct that it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the elastomer rubber material of Walsh by forming it from an open-celled foamed polyurethane material as taught by Burtch, such a modification of Walsh would not have arrived at the claimed subject matter.

Since the examiner has not set forth a prima facie case of obviousness with respect to the claim 1 for the reasons set forth above, the decision of the examiner to reject claim 1, and claims 2 to 4 dependent thereon, under 35 U.S.C. § 103 is reversed.

¹(...continued)
459, 467 (1966).

² We noted that Walsh does not teach a tool comprising a compressible elastomer rubber sponge material. Walsh teaches only that the insert 12 is extruded from an elastomer such as rubber of suitable hardness.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 4 under
35 U.S.C. § 103 is reversed.

REVERSED

NEAL E. ABRAMS
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

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